

## REMARKS

### **I. Introduction**

In the Office Action mailed April 17, 2006, the United States Patent and Trademark Office (hereinafter the "Office") rejected Claims 1-10, 23-32, 33, and 43-44 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,694,331, to Lee et al. (hereinafter "Lee"). Claims 14-22 and 34-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of U.S. Patent No. 6,925,444, to McCollom et al. (hereinafter "McCollom"). Further, Claims 11-13 and 45-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of U.S. Patent No. 6,532,461, to Evans et al. (hereinafter "Evans").

With this amendment and response, Claims 1-13, 15-33, and 35-47 remain pending in this application, with Claims 1, 24, and 33 being independent claims. Pursuant to 37 C.F.R. § 1.111 and for the reasons set forth below, applicants request reconsideration and allowance of this application.

### **II. Claims 1-10, 23-32, 33, and 43-44 Are Patentable Over Lee**

The Office rejected Claims 1-10, 23-32, 33, and 43-44 under 35 U.S.C. § 102(e) as being anticipated by Lee. The Office asserted that Lee discloses each and every element of the claims. Applicants respectfully disagree.

#### **A. Independent Claim 1**

In its amended form, Claim 1 recites:

1. A method for electronically searching a user-personalized library of content, comprising:
  - (a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database;
  - (b) electronically searching the text searchable database for pages of content that match the search terms to produce search results;
  - (c) providing the search results to the user;

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- (d) receiving a search result selection from the user;
- (e) providing to the user an image of a page of content in the page image database based on the user's search result selection; and
- (f) using one or more access rules to limit an amount of content in the image of the page of content being provided to the user.

Claim 1 is directed to a method for electronically searching a user-personalized library of content. As recited in Claim 1, the method specifically requires "electronically searching the text searchable database for pages of content that match the search terms to produce search results," "providing to the user an image of a page of content in the page image database based on the user's search result selection," and **"using one or more access rules to limit an amount of content in the image of the page of content being provided to the user."**

The References Fail to Disclose Access Rules to Limit an Amount of Content in the Page Image Being Provided

Applicants respectfully submit that neither Lee nor McCollom teaches or suggests access rules to limit an amount of content in an image of a page of content being provided to the user. With respect to Claim 14 (now canceled), the Office correctly stated that Lee does not expressly teach this feature. (Office Action, page 7). At best, Lee appears to teach "a search and organization server" for "formulating and facilitating searches for intellectual properties" stored in a patent image database and for displaying images resulting from a search of the patent image database.

In support of the rejection of Claim 14, the Office asserted that McCollum teaches the above-mentioned feature, citing Col. 5, line 39 to Col. 6, line 11 and Col. 10, lines 11-38. The Office further stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Lee with the teaching of McCollom to include using one or more access rules to limit an amount of content in one or more page images provided to the user because it would provide a user interface which allows the user to create a

purchase list by receiving advertisement data on the consumer device." Applicants respectfully disagree.

While the rejection of Claim 14 is now moot, applicants point out that McCollom teaches nothing about access rules to limit an amount of content in an image of a page of content being provided to a user. Instead, the cited passages of McCollom are generally directed to a consumer shopper system (Col. 5, line 39 to Col. 6, line 11) and a coupon creation process of a commerce server (Col. 10, lines 11-38).

More specifically, the consumer shopper system in McCollom allows a user to determine which merchant advertisements to access and further allows the user to subscribe to a specific advertisement or advertisements in a particular category of interest. In accordance with the user's subscription, McCollom's shopper system filters merchant advertisements for delivery to the user. What McCollom fails to teach is "one or more access rules that is used to limit the amount of content in the image of the page of content being provided to the user," as recited in amended Claim 1. Once the merchant advertisements are retrieved based on the user's subscription, the content of the merchant advertisements will not be changed or limited when the merchant advertisements are displayed to the user.

Even if applicants assume that Lee's teaching of a patent image database and McCollom's teaching of filtering merchant advertisements can be combined, at best that combination would result in a system where a user specifies particular patent images or categories of images and the patent image database is filtered to provide only those images. In contrast, the method claimed in Claim 1 is already providing an image of a page of content to the user. The access rules act to limit the amount of content in that page being provided.

For the above reasons, applicants respectfully submit that the cited and applied references (Lee and McCollom) fail to teach or suggest "using one or more access rules to limit an amount of content in the image of the page of content being provided to the user," as recited in Claim 1.

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To establish a proper rejection under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference." (M.P.E.P. § 2131). Furthermore, the identical invention must be shown in as complete detail as is contained in the claim. *Id.* Applicants respectfully submit that Lee fails to expressly or inherently teach, disclose or suggest each and every element of amended Claim 1. Further, as explained above, Lee in view of McCollom also fails to disclose or suggest "using one or more access rules to limit an amount of content image of the page of content being provided to the user, " as recited in Claim 1. Thus, applicants request that the rejection of Claim 1 be withdrawn and the claim allowed.

B. Dependent Claims 2-10 and 23

Claims 2-10 and 23 are dependent on Claim 1 and thus are allowable for the reasons discussed above in connection with Claim 1. Claims 2-10 and 23 also include subject matter not disclosed, taught or suggested by the cited and applied references, particularly when the subject matter is considered in combination with the claims from which these claims depend. For example, Claim 23 recites "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Lee fails to teach, disclose, or suggest. The Office relied on Lee for teaching such an element, citing Col. 5, line 33 to Col. 6, line 34, and Col. 9, line 39 to Col. 10, line 60 of Lee. (Office Action, Page 5.) However, applicants respectfully disagree.

Applicants respectfully assert that the cited passages fail to teach, suggest, or disclose the above-mentioned element since the cited passages merely teach "workspace areas in which to save, edit and organize saved search results, resulting documents, and search criteria." (Col. 5, lines 37-41.) There is no mention of "text data related to the [non-text] object" in the cited passages. Accordingly, applicants respectfully submit that the rejections of Claims 2-10 and 23 are in error, and should be withdrawn.

C. Independent Claim 24

Claim 24, which has not been amended, recites as follows:

24. A method for preparing a user-personalized library of content for electronic searching, comprising:
- (a) acquiring a general library of content that includes images and corresponding text of pages of content;
  - (b) preparing a page image database comprised of the images of pages of content;
  - (c) preparing a text searchable database comprised of the corresponding text of pages of content; and
  - (d) receiving from a user a selection of content in the general library to form a user-personalized library of content that the user can electronically search using the text searchable database.

Claim 24 is directed to a method for preparing a user personalized library of content for electronic searching. As claimed in Claim 23, the method specifically recites "**preparing a page image database** comprised of the images of pages of content" and "**preparing a text searchable database** comprised of the corresponding text of pages of content."

Lee Fails to Disclose "Preparing ... Text Searchable Database"

Simply stated, Lee does not teach or suggest preparing two different databases for efficient search or query purposes that include a **text searchable database** and a **page image database**. Instead, Lee merely teaches a patent image database where a user can retrieve patent images through various search queries. However, the Office asserted that Lee teaches a text searchable database, relying on Col. 7, line 53 to Col. 9, line 16. More specifically, the Office stated that "[C]lass search module 310 may retrieve the additional search criteria from stored search criteria (e.g., imported from a user's work space)" for teaching of "preparing the text searchable database." See Office Action page 4. Although it is not clear on the face, applicants assume that the Office Action intended to state that retrieving additional search criteria from stored search criteria is equivalent to "preparing the text searchable database."

However, Lee clearly states that search criteria or stored search criteria are limited to **data results** for a search on a patent image database. The search criteria can be refined or edited to get a better result from the database. For example, a portion of the cited passages discloses:

The additional search criteria may, for example, **be additional keywords to be searched in an entire document or in select fields** (e.g., detailed description only). Other known limitations (e.g., date restrictions) or search elements (e.g., Boolean logic operators) may be added to further refine the search criteria. The search criteria thus refined or edited may again be transmitted (and/or stored for later transmission) to database 32 (and/or remote systems) for execution on the entire database or only on a selected portion of the database (e.g., the previous search results, updated portions of the database, etc.).

(Col. 7, line 63-Col. 8, line 7, emphasis added.)

However, storing the search criteria or stored search criteria has nothing to do with preparing a text searchable database which includes a text portion of a corresponding page image in a page data image database. Moreover, nowhere in Lee does it teach or suggest that a text searchable database comprises text corresponding to content that is part of a page stored in a page image database. Accordingly, Lee fails to teach, disclose or suggest "preparing a text searchable database comprised of the corresponding text of pages of content" as recited in Claim 24. Accordingly, for this reason, applicants respectfully submit that the rejection of Claim 24 is in error and request that the rejection be withdrawn.

D. Dependent Claims 25-32

Claims 25-32 are dependent on Claim 24 and thus are allowable for the reasons discussed above in connection with Claim 24. Claims 25-32 also include subject matter not disclosed, taught or suggested by any of the cited and applied references, particularly when they are considered in combination with the claims from which they depend. Accordingly, for this reason, applicants respectfully request withdrawal of the rejection of Claims 25-32.

E. Independent Claim 33

In its amended form, Claim 33 recites:

A computer system that provides electronic searching of a user-personalized library of content, comprising a search server in communication with a database server, in which the database server is configured with a general library of content that is accessible to multiple users, the general library including (1) a page image database containing images of pages of content, (2) an access rights database containing access rules that define the scope of content to be displayed to each user, and (3) a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text, the search server being configured with a search engine comprised of computer-implemented instructions that enable the search server to receive one or more search terms from a user having established a personalized library within the general library of content, search the full text of the user's personalized library for pages of content that match the search terms, provide the results of the full text search to the user for selection by the user, and provide to the user a page image from the page image database based on the user's search result selection, the content in the page image being provided within the scope defined by the access rules.

In a manner similar to Claim 1, Claim 33 recites a computer system that provides electronic searching of a user-personalized library of content. As claimed in Claim 33, the computer system specifically recites "the general library including (1) a page image database containing images of pages of content, (2) an access rights database containing access rules that define the scope of content to be displayed to each user, and (3) a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text," and "the content in the page image being provided within the scope defined by the access rules." For reasons similar to those stated above with regard to Claim 1, Lee fails to teach an access rights database containing access rules that define the scope of content and a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text. In addition, and as described

above in connection with Claim 24, Lee fails to teach a text searchable database. Accordingly, applicants respectfully submit that the rejection of Claim 33 is in error and request that the rejection be withdrawn.

F. Dependent Claims 43-44

Claims 43-44 are dependent on Claim 33 and thus are allowable for the reasons discussed above in connection with Claim 33. Claims 43-44 also include subject matter not disclosed, taught or suggested by any of the cited and applied references, particularly when the subject matter is considered in combination with the subject matter of the claims from which these claims depend. For example, Claim 44 recites "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Lee fails to teach, disclose, or suggest. However, the Office relied on Lee for teaching of such element, citing Col. 5, line 33 to Col. 6, line 34, and Col. 9, line 39 to Col. 10, line 60 of Lee. (Office Action, page 5.) Applicants respectfully disagree.

As with Claim 23, applicants respectfully assert that the cited passages fail to teach, suggest, or disclose the above-mentioned element of Claim 44 since the cited passages merely teach "workspace areas in which to save, edit and organize saved search results, resulting documents, and search criteria." (Col. 5, lines 37-41.) There is no mention about "text data related to the [non-text] object" in the cited passages. Applicants respectfully submit that Claims 43 and 44 are patentable.

**III. Claims 11-22, 34-42, and 45-47 Are Patentable Over Lee, McCollom and Evans**

In the Office Action, Claims 11-22, 34-42, and 45-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in combination with McCollom, or Lee in combination with McCollom and Evans. Claims 14 and 34 have been canceled, thus, the rejections of Claims 14 and 34 are moot.

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To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, to establish a proper rejection under 35 U.S.C. § 103, M.P.E.P. § 2143 states that

Three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(M.P.E.P. § 2143, emphasis added.)

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.

*In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (emphasis added).

A. Dependent Claims 11-13, 15-22, 35-42 and 45-47

As a preliminary matter, applicants note that Claims 11-13 and 15-22 depend from independent Claim 1. Applicants respectfully submit that these claims are allowable for the reasons described above in regard to Claim 1. In addition, Claims 35-42 and 45-47 depend from independent Claim 33 and are also submitted to be allowable for the reasons described above in regard to Claim 33.

Moreover, Claims 11-13, 15-22, 35-42, and 45-47 include subject matter not disclosed, taught, or suggested by any of the cited and applied references, particularly when the subject matter is considered in combination with the recitations of the claims from which these claims depend. For example, Claims 15 and 36, discussed below, recite additional features which are not taught or suggested by any of the cited and applied references, either alone or in combination thereof.

B. Claims 15 and 36

Claims 15 and 36 each recite "the access rules define an aggregate amount of content that can be provided to the user over a time frame." The Office relied on Col. 18, line 65 to Col. 19, line 19 of McCollom as allegedly teaching access rules that define an aggregate amount of content that can be provided to the user over a time frame.

The cited text discloses:

Illustrated in FIG. 18 is a flow diagram of the consumer purchase process 310 for the **consumer shopper program 70** of the present invention. ... If the check of the user password at step 313 is satisfactory, the user buy process 310 checks if **the payment amount input at step 312 exceeds the spending unit of the user** at step 314. If the spending limit for the user is exceeded at step 314, the user buy process 310 proceeds to step 329 to exit the user buy process. If the user has not exceeded the spending limits at step 314, the user buy process 310 then checks if the user has elected to redeem a coupon with a purchase at step 315. ... In either case, the user buy process 310 transmits a buy request to the merchant including the item and coupon information at step 321.

(Col. 18, line 65 to Col. 19, line 19 of McCollom, emphasis added.)

The cited passage is merely directed to a user buy process 310 for checking whether the **spending limit** of the user exceeds **the payment amount input** for an item before transmitting a buy request to a merchant. Clearly, a spending limit of a purchase transaction is different from the aggregate amount of content in a page image which can be provided over time. Thus, McCollom fails to teach the above element recited in Claims 15 and 36. A case of *prima facie* obviousness has not been established.

For the reasons set forth above, applicants submit that Claims 15 and 36 should be allowed.

IV. Conclusion

In view of the foregoing amendments and remarks, applicants submit that all pending claims are in patentable condition and respectfully request an early notice to that effect. The

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Examiner is requested to contact applicants' attorney at the number provided below should any questions or issues remain.

Respectfully submitted,

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